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| 10/573,218   | 10/16/2006  | Kimberley Hanke      | 3192.00004          | 4947             |
| Kenneth I Kohn<br>Kohn & Associates<br>30500 Northwestern Highway<br>Suite 410<br>Farmington Hills, MI 48334 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| SILVER, DAVID  |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 2128   |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/573,218

**Applicant(s)**

HANKE, KIMBERLEY

**Examiner**

DAVID SILVER

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-22 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 24 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. Claims 1-22 are pending in Instant Application.

#### ***Priority***

2. Examiner acknowledges Applicant's claim to priority benefits of PCT/US04/33925 International Filing Date: 10/14/2004 Which Claims Priority from Provisional Application 60511000, filed **10/14/2003**.

#### ***Information Disclosure Statement***

3. No IDS submitted for consideration. Applicants are respectfully reminded of their duty to disclose.

#### ***Specification***

4. The use of the trademarks has been noted in this application. Trademarks should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. See, for example, page 3 lines 15-19 of the Specification.

Appropriate correction is required.

#### ***Claim Objections***

5. Applicant is advised that should claim 1/5 be found allowable, claim 20/21 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

#### ***Claim Interpretation***

6. Limitations drawn to allowing, enabling or making optional a function's performance does not further limit a claim. As such, any prior art not explicitly prohibiting the performance of the function inherently anticipates the limitation.

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***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7.1 In this instance, absent an explicit and deliberate definition in the specification that the product includes an appropriate medium or hardware elements, the claims are directed to software, *per se*. Note exemplary claim 1 which recites only software elements. Additionally, software, *per se*, is not considered concrete (MPEP 2106). The "means for" is actually software, as demonstrated by claim 2.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 18, the term "and similar softwares" renders the claim indefinite as it fails to set the metes and bounds of the claim.

9. The above cited rejections are merely exemplary.
10. The Applicant(s) are respectfully requested to correct all similar errors.
11. Claims not specifically mentioned are rejected by virtue of their dependency.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on

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sale in this country, more than one year prior to the date of application for patent in the United States.

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-6, 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Gregg (**US 4977529**).

Gregg discloses: 1. An automated three-dimensional and related data access system, said system comprising manipulating means for virtually manipulating, testing, and controlling the three-dimensional and related data (**col: 184 line: 23-38; col: 185 line: 39-61**).

Gregg discloses: 2. The system according to claim 1, wherein said manipulating means is software (**Fig 8 and description**).

Gregg discloses: 3. The system according to claim 1, wherein said three-dimensional and related data include objects (**col: 184 line: 23-38; col: 185 line: 39-61**).

Gregg discloses: 4. The system according to claim 3, wherein said objects are selected from the group consisting essentially of physical objects, virtual objects, holographic objects, and photogramic objects (**col: 184 line: 23-38; col: 185 line: 39-61**).

Gregg discloses: 5. The system according to claim 1, further including remote deploying means for remotely deploying the three-dimensional and related data (**Fig 89/1 and 89/6 and descriptions**).

Gregg discloses: 6. The system according to claim 5, wherein said deploying means is selected from the group consisting essentially of phone lines, modem, TI line, Internet, DSL, cable modem, dial-up Internet, wide area network, Intranet, local area network, ISDN, wireless connections, satellite communications, direct cable connection, and T3 communications (**Fig 89/1 and 89/6 and descriptions**).

Gregg discloses: 17. The system according to claim 1, wherein said manipulating means includes viewing means for viewing assembly and disassembly of products, components, and structures (**col: 184 line: 23-38; col: 185 line: 39-61**).

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Gregg discloses: 18. The system according to claim 2, wherein said software is selected from the group consisting essentially of CATIA, Unigraphics, Allias, Mya, Enovia, Kaon, Pro-E, AutoCad, and similar softwares (**Fig 8 and description**).

Gregg discloses: 19. The system according to claim 1, wherein the three-dimensional models include multi-dimensional data (**col: 184 line: 23-38; col: 185 line: 39-61**).

As per claims 20, note the rejection of claim 1 above. The Instant Claims recite substantially same limitations as the above-rejected claim and are therefore rejected under same prior-art teachings.

As per claims 21, note the rejection of claim 5 above. The Instant Claims recite substantially same limitations as the above-rejected claim and are therefore rejected under same prior-art teachings.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gregg (**US 4977529**) as applied to claim 1 above, and further in view of Scott (**US 4,480,480**).

As per claim 7, Gregg fully discloses parent claim 2. Gregg however does not expressly disclose (although hints at, in (**col: 11 line: 23-32**)) that said manipulating means includes a device for estimating accident damage and structural integrity. Scott however discloses an analogous invention having the said feature (**Fig 22-27 and their descriptions**).

In view of the KSR v. Teleflex Supreme Court ruling, it is asserted that one of ordinary skill in the art could have combined the elements as claimed by known methods and that in combination, each element merely would have performed the same function as it did separately. Furthermore, one of ordinary skill

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in the art would have recognized that the results of the combination were predictable. Specifically, when damage occurs, one would want to estimate the damage as well as assess the results of the damage (including costs of repair, and whether repairs are required - based on structural integrity).

See MPEP 2145 [R-6], X, B, " [A] person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely that product [was] not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103." KSR International Co. v. Teleflex Inc., 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1397 (2007).

14. Claims 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregg (**US 4977529**) as applied to claim 1 above, and further in view of Scott (**US 4,480,480**), and further in view of Uegaki (**US 20020161533**)

As per claim 8, the combination of Gregg and Scott discloses: 8. The system according to claim 7, further including predicting means for predicting damage caused during an accident (**col: 19 line: 9-16**). The combination however does not expressly disclose determining means for determining costs for repairing parts damaged during the accident. Uegaki however discloses an analogous system having the said feature (**para 2, 8, 13**).

In view of the KSR v. Teleflex Supreme Court ruling, it is asserted that one of ordinary skill in the art could have combined the elements as claimed by known methods and that in combination, each element merely would have performed the same function as it did separately. Furthermore, one of ordinary skill in the art would have recognized that the results of the combination were predictable. Specifically, when damage occurs, one would want to estimate the damage as well as assess the results of the damage (including costs of repair, and whether repairs are required - based on structural integrity).

See MPEP 2145 [R-6], X, B, " [A] person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely that product [was] not

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of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.” KSR International Co. v. Teleflex Inc., 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1397 (2007).

Uegaki discloses: 9. The system according to claim 8, wherein said predicting means includes warning indicia that indicate parts that are destroyed as a result of the accident (**para 12, 15: when parts are replaced**).

Uegaki discloses: 10. The system according to claim 8, wherein said predicting means includes cautionary indicia that indicate parts that potentially have lost structural integrity as a result of the accident (**para 64**).

Uegaki discloses: 11. The system according to claim 8, wherein said predicting means includes approving indicia that indicate parts that have no damage as a result of the accident (**para 64: the parts that are not listed are inherently indicated as not being damaged**).

Uegaki discloses: 12. The system according to claim 8, wherein said determining means includes software that analyzes the predicted damage and converts the damage into the cost for repairing the damage (**para 66**).

Uegaki discloses: 13. The system according to claim 8, further including ordering means for ordering the damaged parts (**para 51 (user)**).

Uegaki discloses: 14. The system according to claim 8, further including an accompanying tool list for use in repairing the parts (**para 66**).

Uegaki discloses: 15. The system according to claim 10, wherein said predicting means includes cautionary indicia that indicate parts that potentially have lost structural integrity as a result of potential failures (**para 64-66**).

Uegaki discloses: 16. The system according to claim 10, wherein said predicting means includes cautionary indicia that indicate parts that potentially have lost structural integrity as a result of nature (**para 64-66**).



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15. Claims 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregg (**US 4977529**) as applied to claim 1 above, and further in view of Wilson (**US 6,670,908**)

As per claim 22, Gregg fully discloses claim 21. Gregg however does not expressly disclose that said system further includes automatic analysis and notification means for notifying relevant regional authorities based on severity, type of event, and potential area and population affects. Wilson however discloses an analogous invention having the said feature (**col: 4 line: 63-67**).

In view of the KSR v. Teleflex Supreme Court ruling, it is asserted that one of ordinary skill in the art could have combined the elements as claimed by known methods and that in combination, each element merely would have performed the same function as it did separately. Furthermore, one of ordinary skill in the art would have recognized that the results of the combination were predictable. Specifically, when the damage occurs, one would want to know the affected entities. In the case of natural causes / power plant damages, the entities are the surrounding population. Accordingly, it would have been obvious to also notify the authorities such that help may be sent to where it is needed.

See MPEP 2145 [R-6], X, B, " [A] person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely that product [was] not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103." KSR International Co. v. Teleflex Inc., 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1397 (2007).

#### ***Support for Amendments and Newly Added Claims***

Applicants are respectfully requested, in the event of an amendment to claims or submission of new claims, that such claims and their limitations be directly mapped to the specification, which provides support for the subject matter. This will assist in expediting compact prosecution. MPEP 714.02 recites: "Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06. An amendment which does not comply with the provisions of 37 CFR 1.121(b), (c), (d), and (h) may be held not fully responsive. See MPEP § 714." **Amendments not pointing to specific**

**support in the disclosure may be deemed as not complying with provisions of 37 C.F.R.**

**1.131(b), (c), (d), and (h) and therefore held not fully responsive.** Generic statements such as "Applicants believe no new matter has been introduced" may be deemed insufficient.

#### ***Requests for Interview***

16. In accordance with 37 CFR 1.133(a)(3), requests for interview must be made in advance.

Interview requests are to be made by telephone (571-272-8634) call or FAX (571-273-8634).

Applicants must provide a detailed agenda as to what will be discussed (generic statement such as "discuss §102 rejection" or "discuss rejections of claims 1-3" may be denied interview).

The detail agenda along with any proposed amendments is to be written on a PTOL-413A or a custom form and should be faxed (or emailed, subject to MPEP 713.01.I / MPEP 502.03) to the Examiner at least 3 days prior to the scheduled interview.

17. Interview requests submitted within amendments may be denied because the Examiner was not notified, in advance, of the Applicant Initiated Interview Request and due to time constraints may not be able to review the interview request to prior to the mailing of the next Office Action.

#### ***Conclusion***

18. All claims are rejected.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Silver whose telephone number is (571) 272-8634. The examiner can normally be reached on Monday thru Friday, 10am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on 571-272-2279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available

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through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/ DS / \_\_\_\_\_

David Silver, Patent Examiner  
Art Unit 2128

/Michael D Masinick/  
Primary Examiner, Art Unit 2128